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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/289,305	04/09/1999	GLENN BEGIS	10559/008001	8436
20985	7590	02/26/2004		
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			EXAMINER ABELSON, RONALD B	
			ART UNIT 2666	PAPER NUMBER 12

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/289,305

Applicant(s)

BEGIS, GLENN

Examiner

Ronald Abelson

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2003 and 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,8-10,12,13 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) 25-29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5,8-10,12,13 and 15-24 is/are allowed.
- 6) ☒ Claim(s) 1-5,8-10,12,13 and 15-24 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 25-29 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 2666

1. The applicant must explicitly cancel claims 25-29 in the next response, per telephone conversation on 2/18/04.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 4, 5, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Weingarten (US 6,078,579).

Regarding claims 4 and 8, Weingarten teaches establishing a connection across a first communication network that carries audio signals (fig. 5 element 80, col. 8 lines 10-13).

The system comprises encoding a computer network address for a second network different from the first network into an encoded network address and sending the encoded network address across the first network (col. 8 lines 36-40).

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Art Unit: 2666

The system comprises using the network address that is sent over the first network to establish a network connection on said second network (col. 8 lines 36-40).

Regarding claim 4, Weingarten teaches the encoded network address is appended to telephone network signaling data (col. 8 lines 36-40).

Regarding claim 8, Weingarten teaches the system comprises receiving a stream of audio signals (col. 7 lines 63-67).

Regarding claim 8, Weingarten teaches the system comprises sending the audio signals through the connection across the voice telephone network prior to said using said network address to establish a network connection (once the conversation is established, col. 8 line 10-14).

Regarding claim 8, Weingarten teaches the system comprises sending the audio signals through the connection across the computer network after said using said network address to establish a network connection (col. 7 lines 63-67).

Regarding claim 5, the second network comprises the Internet (Weingarten: col. 8 lines 36-40).

Art Unit: 2666

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 2, 9, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weingarten (US 6,078,579) in view of Rasmussen (US 5,222,136).

Regarding claims 1, 9, and 12-13, Weingarten teaches establishing a connection across a first communication network that carries audio signals (fig. 5 element 80, col. 8 lines 10-13); encoding a computer network address for a second network different from the first network into an encoded network address and sending the encoded network address across the first network (col. 8 lines 36-40); using the network address that is sent over the first network to establish a network connection on said second network (col. 8 lines 36-40); and maintaining the first connection across the first communication network while the second network connection is being established (col. 8 lines 40-45).

Art Unit: 2666

Regarding claim 9, in addition to the limitations previously listed, Weingarten teaches receiving a stream of audio signals (col. 7 lines 63-67).

Regarding claim 12, in addition to the limitations previously listed, Weingarten teaches the first network is a voice telephone network (conversation, col. 8 line 14) and the second network is a computer network (ISP, col. 8 lines 40-45) and translating the encoded network address to a computer network address (establish a connection over the Internet, col. 8 lines 36-40).

Regarding claim 13, in addition to the limitations previously listed, Weingarten teaches obtaining a computer network address for a computer network (IP address, col. 8 lines 36-38). Note, in claim 13, the second network is the telephone network.

Although Weingarten teaches voice communication, the reference is silent on providing encryption capabilities, wherein providing the encryption capabilities comprise encrypting the audio signal using an encryption key as specified

Art Unit: 2666

in claim 1; transferring a secret key across at least one of the network connections, as specified in claim 2; allowing network users to converse across the first communication network while encrypting and decrypting audio signals for each user, as specified in claim 2; encrypting the audio signals using a first computer that is connected to the second network to form encrypted audio signals, as specified in claim 9; sending the encrypted audio signals across the network connection, as specified in claim 9.

Rasmussen teaches providing encryption capabilities, wherein providing the encryption capabilities comprise encrypting the audio signal using an encryption key (fig. 1 box 12a,b, <sup>10</sup> col. 4 lines 62-64, col. 2 lines 50-57), as specified in claim 1; transferring a secret key across at least one of the network connections (fig. 1 box 12a,b, <sup>20</sup> col. 4 lines 62-64, col. 2 lines 50-57), as specified in claim 2; allowing network users to converse across the first communication network while encrypting and decrypting audio signals for each user (col. 4 lines 13-17), as specified in claim 2; encrypting the audio signals using a first computer that is connected to the second network to form encrypted audio signals (fig. 1 box 12a,b, col. 4 lines 62-64, col. 2 lines 50-57), as specified in claim 9; and sending the encrypted audio signals across the network

Art Unit: 2666

connection (fig. 1 box 12a,b, col. 4 lines 62-64, col. 2 lines 50-57), as specified in claim 9.

Therefore it would have been obvious to one of ordinary skill in the art, having both Weingarten and Rasmussen before him/her and with the teachings [a] as shown by Weingarten, a simultaneous connection over a telephone and computer network, and [b] as shown by Rasmussen, providing encryption capabilities, wherein providing the encryption capabilities comprise encrypting the audio signal using an encryption key, to be motivated to modify the system of Weingarten by inserting an encrypted communication devices (Rasmussen: fig. 1 box 12a,b) between the telephones and telephone lines of Weingarten. This would improve the system by allowing for secure communication.

6. Claims 10 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weingarten in view of Batten-Carew (6,603,857).

Regarding claims 10 and 15, Weingarten teaches establishing a connection across a first communication network that carries audio signals (fig. 5 element 80, col. 8 lines 10-13); encoding a computer network address for a second network different from the first network into an encoded network address and sending



Art Unit: 2666

the encoded network address across the first network (col. 8 lines 36-40); using the network address that is sent over the first network to establish a network connection on said second network (col. 8 lines 36-40).

Weingarten is silent on transmitting an encryption key across the second network using the network connection and encrypting an audio signal using the encryption key to form an encrypted audio signal.

Batten-Carew teaches transmitting an encryption key across the second network / Internet using the network connection and encrypting an audio signal using the encryption key to form an encrypted audio signal (fig. 1 box 14, col. 2 line 65 - col. 3 line 3).

Therefore it would have been obvious to one of ordinary skill in the art, having both Weingarten and Batten-Carew before him/her and with the teachings [a] as shown by Weingarten, a simultaneous connection over a telephone and computer network, and [b] as shown by Batten-Carew , transmitting an encryption key across the second network / Internet using the network connection and encrypting an audio signal using the encryption key to form an encrypted audio signal, to be motivated to modify the system of Weingarten by transmitting an encryption key over the Internet. This

Art Unit: 2666

modification can be performed according to the algorithm of Batten-Carew (col. 3 lines 4-23). This would improve the system by allowing for secure communication over the Internet.

Regarding claims 10 and 15, the limitation, transmitting the encrypted audio signal across the first network, the concept of transmitting encrypted signals has been discussed already in this claim. Regarding sending the signal across the first network, the examiner equates this limitation with transmitting data over the Internet and then switching back to the conventional phone lines (Weingarten: col. 7 lines 63-67).

Regarding claim 17, the examiner maintains all the limitations are found in claims 10 and 15.

Regarding claim 16, encoding a computer network address into an encoded network address (col. 8 lines 36-40), sending the encoded network address across the first network (col. 8 lines 36-40), using the network address to establish a network connection across the network (col. 8 lines 36-40).

7. Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Weingarten in view of Fougnes (US 6,434,378).

Art Unit: 2666

Weingarten teaches establishing a connection across a first communication network that carries audio signals (fig. 5 element 80, col. 8 lines 10-13); encoding a computer network address for a second network different from the first network into an encoded network address and sending the encoded network address across the first network (col. 8 lines 36-40); and using the network address that is sent over the first network to establish a network connection on said second network (col. 8 lines 36-40).

Weingarten fails to teach encoding using dual tone multi-frequency signals (DTMF).

Fougnies teaches encoding using dual tone multi-frequency signals (fig. 7 box 83, col. 5 lines 54-56).

Therefore it would have been obvious to one of ordinary skill in the art, having both Weingarten and Fougnies before him/her and with the teachings [a] as shown by Weingarten, establishing a connection across a first communication network that carries audio signals, encoding a computer network address for a second network different from the first network into an encoded network address and sending the encoded network address across the first network, and using the network address that is sent over the first network to establish a network connection on said second network, and [b] as shown by Fougnies, encoding

Art Unit: 2666

using dual tone multi-frequency signals, to be motivated to modify the system of Weingarten by transmitting the encoded signal using DTMF signals. This could be implemented by using the encoder/decoder of Fougnes (fig. 7 box 83). This would improve the system since encoding using DTMF is a standardized method. By encoding using DTMF would enable the system to be easily integrated with other systems.

The combination of Weingarten and Fougnes is silent on providing encryption capabilities, wherein providing the encryption capabilities comprise encrypting the audio signal using an encryption key.

Rasmussen teaches providing encryption capabilities, wherein providing the encryption capabilities comprise encrypting the audio signal using an encryption key (fig. 1 box 12a,b,<sup>2</sup> col. 4 lines 62-64, col. 2 lines 50-57). *id codes*

Therefore it would have been obvious to one of ordinary skill in the art, having both the combination of Weingarten and Fougnes and Rasmussen before him/her and with the teachings [a] as shown by the combination of Weingarten and Fougnes, a simultaneous connection over a telephone and computer network, and [b] as shown by Rasmussen, providing encryption capabilities, wherein providing the encryption capabilities comprise encrypting the audio signal using an encryption key, to

Art Unit: 2666

be motivated to modify the system of Weingarten by inserting an encrypted communication devices (Rasmussen: fig. 1 box 12a,b) between the telephones and telephone lines of Weingarten. This would improve the system by allowing for secure communication.

8. Claims 18, 19, 21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weingarten in view of Gruen (US 6,393,460).

Regarding claims 18, 23, and 24, Weingarten teaches establishing a connection across a first communication network that carries audio signals (fig. 5 element 80, col. 8 lines 10-13).

The system comprises establishing a connection across a computer network between a calling computer and a receiving computer (col. 8 lines 36-40).

Weingarten is silent on verifying that the calling computer is coupled to the calling telephone by sending a signal from the receiving telephone to the calling telephone across the voice communication network and sending the signal from the calling computer to the receiving computer across the computer network.

Gruen teaches a method for sending the signal from the calling computer to the receiving computer across the computer network (Instant Messenger from AOL, col. 4 lines 10-11), as

Art Unit: 2666

specified in claims 18, 23, and 24; and authenticating the calling computer (Instant Messenger from AOL, col. 4 lines 10-11), as specified in claim 19.

Therefore it would have been obvious to one of ordinary skill in the art, having both Weingarten and Gruen before him/her and with the teachings [a] as shown by Weingarten, a simultaneous connection over a telephone and computer network, and [b] as shown by Gruen, a method for sending the signal from the calling computer to the receiving computer across the computer network, to be motivated to modify the system of Weingarten by having the caller send a message over the telephone and then have the callee send the same message over the computer network to the caller using a program like Instant Messenger. This would improve the system of Weingarten by verifying that both telephone and computer connections have been established.

Regarding claim 21, in addition to the limitations previously listed, encoding a computer network address for a second network different from the first network into an encoded network address (Weingarten: col. 8 lines 36-40).

The system comprises sending the encoded network address across the first network (Weingarten: col. 8 lines 36-40).

Art Unit: 2666

The system comprises receiving the network address to establish a network connection across the computer network (Weingarten: col. 8 lines 36-40).

9. Claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Weingarten and Gruen in view of Baba (US 5,987,129).

As shown in claim 18, Weingarten teaches simultaneous communication over a voice network and a computer network.

The combination of Weingarten and Gruen is silent on cryptographic messaging.

Baba teaches generating a random number (fig. 8 box 9).

Baba teaches a device for sending the random number (fig. 8, computer, col. 12 lines 20).

Baba teaches encrypting a random number (fig. 8 box 8).

Baba teaches decrypting a random number (fig. 8 box 8) using a public cryptographic key (fig. 8 box 7, common key, col. 12 lines 26-29).

Therefore it would have been obvious to one of ordinary skill in the art, having both the combination of Weingarten and Gruen and Baba before him/her and with the teachings [a] as shown by the combination of Weingarten and Gruen, a simultaneous connection over a telephone and computer network, and [b] as

Art Unit: 2666

shown by Baba, encryption and decryption of random numbers using public cryptographic keys, to be motivated to modify the system of the combination of Weingarten and Gruen by having the receiving party generate a random number on his computer and tell the calling party that number over the phone. Then the receiving party would verbally communicate the random number to the calling party over the voice network. The calling party would then send the encrypted random number as well as the common cryptographic key / cryptokey (Baba fig. 7) to the receiving party over the computer network. The receiving party would then decrypt the encrypted random number using the common cryptographic key and compare the original random number sent with the decrypted random number received. This modification could be performed using the system of Baba (fig. 8). This would improve the system by providing a means of secure communication over the computer network by using encryption.

#### ***Response to Arguments***

10. Applicant's arguments with respect to claims 1-5, 8-10, 12, 13, and 15-24 have been considered but are moot in view of the new ground(s) of rejection (applicant: Amendment C pgs. 14-17). Therefore, an updated search was performed.




Art Unit: 2666

**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Abelson whose telephone number is (703) 306-5622. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on (703) 308-5463. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

  
Ronald Abelson  
Examiner  
Art Unit 2666

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CHAU NGUYEN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600